

**REMARKS**

Claims 1-2, 5-7, and 10-18 had been pending, claims 3-4 and 8-9 having been previously cancelled. In this paper, claims 1 and 6 have been amended, without disclaimer, to recite “[a] method of purifying contaminated soil containing clay or silt by microorganisms, comprising adding perlite to contaminated soil....” Support for this amendment may be found at least in original claims 5 and 10 and in the specification at page 9, lines 14-15. Claims 5 and 10, which had recited perlite, have been cancelled, also without disclaimer.

Thus, with these amendments, claims 1-2, 6-7, and 11-18 are pending for examination in this application.

**Rejection of Claims 1, 6, 15, 16, 17, and 18 under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1, 6, 15, 16, 17, and 18 under 35 U.S.C. § 102(b), as being anticipated by Rhykerd et al. (“Rhykerd”). Action at page 2. As is well known, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

Solely to expedite prosecution and without acquiescing to the rejection, Applicants have amended claims 1 and 6. Claims 15 and 16 depend from claim 1. Claims 17 and 18 depend from claim 6. As amended, independent claims 1 and 6 recite: “[a] method of purifying contaminated soil containing clay or silt by microorganisms, comprising adding perlite to contaminated soil containing clay or silt....”

Rhykerd does not teach or suggest “adding perlite to contaminated soil containing clay or silt....” See claim 1. Rhykerd only contemplates the addition of vermiculite. See, e.g., Rhykerd at page 281, first paragraph.

Applicants submit that the amendment of claims 1 and 6 should obviate the Examiner's rejection. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 6, 15, 16, 17, and 18 under 35 U.S.C. § 102(b).

**Rejection of Claims 11, 12, 13, and 14 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 11, 12, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Rhykerd. Action at page 3. To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. M.P.E.P. § 2142-43 at 2100-125 – 2100-131.

As discussed above, solely to facilitate prosecution and without acquiescing to the rejection, Applicants have amended claims 1 and 6 to recite “perlite.” Claims 11 and 12 depend from claim 1. Claims 13 and 14 depend from claim 6. Rhykerd does not teach or suggest all the claim limitations, particularly adding “adding perlite to contaminated soil containing clay or silt...” See claims 1 and 6. Rhykerd only contemplates the addition of vermiculite. See, e.g., Rhykerd at page 281, left column.

Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 11, 12, 13, and 14 under 35 U.S.C. § 103(a).

**Rejection of Claims 5 and 10 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 5 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Rhykerd in view of Gardening Series Basics Choosing a Soil Amendment (“Gardening Series”). Action at page 4.

Applicants note that claims 5 and 10 have been cancelled, the limitation of “perlite” now being found in independent claims 1 and 6. However, in the interest of furthering prosecution, Applicants will address this rejection with respect to claims 1 and 6.

The Examiner acknowledges that Rhykerd fails to teach the use of perlite, but contends that the use of perlite in high clay soils would come from Gardening Series. Action at page 4. However, one of ordinary skill in the art would not combine the references as suggested by the Examiner. *See* M.P.E.P. § 2146 at 2100-160.

Rhykerd teaches a treatment of contaminated soil using vermiculite as a bulking agent to increase porosity and to enhance bioremediation. *See* Rhykerd at page 280, left column; *see also id.* at page 281, left column. However, the contaminated soil Rhykerd uses in the experiments is “a Bowie fine sandy loam.” *See* Rhykerd at page 280, right column. Gardening Series, on the other hand, teaches that vermiculite “is not a good choice for clay soils because of its high water retention.” Gardening Series at 3. One of ordinary skill in the art would have no reason to use perlite in fine sandy loam if vermiculite were an acceptable choice.

Thus, there would be no reason to combine Rhykerd and Gardening Series, and a *prima facie* case of obviousness cannot be supported. *See* M.P.E.P. § 2146 at 2100-160; *see also* M.P.E.P. § 2143.01 at 2100-127.

**Rejection of Claims 2 and 7 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 2 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Rhykerd in view of Glaze et al. (U.S. Patent No. 5,593,888) (“Glaze”). Action at page 4. Applicants submit that the amendment of claims 1 and 6 to recite “perlite” obviates these rejections. Neither Rhykerd nor Glaze teaches or suggests all the claim limitations, particularly the addition of perlite. *See* claims 1 and 6. Rhykerd discloses the addition of vermiculite. *See, e.g.,* Rhykerd at page 281, left column. Glaze teaches the addition of inorganic amendments, such as sand or gravel, that do not absorb water. *See* Glaze at Col. 12, lines 9-12; *see also* Glaze

at Col. 11, lines 29-31; Col. 9, lines 45-48; Col. 8, lines 4-12. However, the addition of perlite, an inorganic amendment that does absorb water, is not taught in Glaze. *See id.*

Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2 and 7 under 35 U.S.C. § 103(a).

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and the timely allowance of the pending claims. With these amendments, Applicants submit that this application is in good condition for allowance. If the Examiner does not find the claims allowable, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6611 to set up an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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